

APPLICANT(S): LEVY, Sharon
SERIAL NO.: 09/459,598
FILED: 12/14/1999
Attorney Docket No.: P-5351-US
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REMARKS

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Office Action and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application are respectfully requested.

Applicant asserts that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the pending claims are respectfully requested.

Status of Claims

Claims 1, 3-9, 11, 15-19, 21-24, 26, 17, 29-31, 33 and 43-49 are pending in the application. Claims 1, 6-9, 23 and 43-49 have been amended.

Claims 2, 3, 10, 12-14, 20, 25, 28, 32 and 34-42 have been canceled without prejudice or disclaimer. In making this cancellation without prejudice, Applicants reserve all rights in these claims to file divisional and/or continuation patent applications.

Allowable Subject Matter

The Office Action stated that claims 43-49 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, second paragraph.

Claims 43-49 have been amended to overcome the rejections under 35 U.S.C. 112, second paragraph, as described below.

In view of these amendments, Applicant respectfully submits that claims 43-49 are now in condition for allowance.

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Claim Objections

The Office Action objected to claim 1, 23 and 43 because there is insufficient information in the preamble of the claim. Applicant traverses this objection because Applicants believes that the objection is inconsistent with MPEP 2111.02, which states (among other things):

The claim preamble MUST be read in the context of the ENTIRE CLAIM. If the body of the claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of NO SIGNIFICANCE TO CLAIM CONSTRUCTION. (emphasis added)

The Office Action appears to have stopped the Examination of claims 1, 23 and 43 at the preamble, without reading the claim as a whole, which is contrary to the requirements of MPEP 2111.02 (e.g., "The claim preamble MUST be read in the context of the ENTIRE claim"). Applicant would also like to point out that the broad statement of 37 CFR 1.75(a) cannot be properly interpreted in a manner contrary to the Examination procedures set forth in MPEP 2111.02 and contrary to the case law of the Federal Circuit mentioned in MPEP 2111.02. The Applicant hereby requests the Examiner to examine the preamble in the context of claim 1, 23 and 43 in its entirety as required under MPEP 2111.02, or to otherwise withdraw the objection.

Applicant has voluntarily amended independent claim 43, and all the claims dependent therefrom, to replace the term "apparatus" in the preamble with the term --decoder--. It is respectfully submitted that the above arguments regarding the objection to the preamble of claim 43 are applicable to the amended claims.

In view of the above, Applicant respectfully requests withdrawal of the objections to the preambles.

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CLAIM REJECTIONS

35 U.S.C. § 112 Rejections

The Office Action rejected claims 43-49 under 35 U.S.C. § 112, second paragraph, because these claims recite language such as "long term storage area" and "short term storage area" and suggested using instead terminology such as "volatile" and "non volatile". Applicant asserts that the suggested terminology is not applicable to the intended subject matter of these claims.

Claims 43-49 have been amended to replace the phrases "short term" and "long term" with the terms --first-- and --second--, respectively. Without conceding the appropriateness of the indefiniteness objections, Applicant respectfully submits that the new terminology in the amended claims meets the requirements of 35 U.S.C. 112, second paragraph. Applicant further submits that this amendment does not narrow the scope of claims 43-49.

It is respectfully asserted that the foregoing amendment merely addresses matters of form and does not change the literal scope of the claim in any way or result in any prosecution history estoppel.

Applicant respectfully asserts that these amendments render claims 43-49 proper under 35 USC 112 and requests that the rejections be withdrawn.

35 U.S.C. § 103 Rejections

The Office Action rejected claims 1, 3-9, 11, 13-19, 21-27, 29-31 and 33 under 35 U.S.C. § 103(a), as being unpatentable over Lerzar (USPN 6343368B1) further in view of Viterbi et. al. (USPN 5933462).

In view of the above amendments and the following remarks, Applicant respectfully requests that this rejection be withdrawn.

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Claims 3, 12-14, 25 and 35 have been canceled and, thus, Applicant respectfully submits that the rejection of these claims is now moot and does not need to be addressed.

As to the non-canceled rejected claims 1, 4-9, 15-19, 21-24, 26-27, 29-31 and 33, it is well established that an obviousness rejection requires a teaching or a suggestion by the relied upon prior art of all the elements of a claim (MPEP 2142).

Applicant respectfully asserts that neither Lerzar nor Viterbi, alone or in combination, teach or suggest the limitations of claims 1, 4-9, 15-19, 21-24, 26-27, 29-31 and 33, as amended.

Specifically, neither Lerzar nor Viterbi, alone or in combination, teach or suggest "recursively calculating state metric vectors from a block of symbols and storing at a first storage area reference vectors corresponding to a selected group of the calculated state metric vectors", as recited in amended claim 1.

Accordingly, Applicant respectfully assert that a *prima facie* case of obviousness over claim 1 cannot be established, and Applicant respectfully request that the rejection be withdrawn.

Claims 4 – 9, 11, 15 – 19 and 21 are dependent from claim 1 and, therefore, it is respectfully submitted that these claims are patentable at least for the reason given above. Accordingly, Applicant respectfully requests that the rejection of amended claims 4 – 9, 11 and 15 – 19 and 21 also be withdrawn.

Claim 23, as amended, recites, inter alia, "storing reference vectors selected from the calculated state metric vectors; and re-calculating the state metric vectors from the block of symbols in a second direction based on the stored reference vectors". Applicant respectfully asserts that neither Lerzar nor Viterbi, alone or in combination, teach or suggest at least "storing selected reference vector from the calculated state metric vectors ", as recited in amended claim 23.

Accordingly, Applicant respectfully submits that a *prima facie* case of obviousness over claim 23 cannot be established, and Applicant respectfully requests that the rejection of claim 23 be withdrawn.

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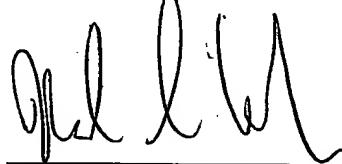
Since claims 24, 26-27, 29-31 and 33 are dependent from claim 23, Applicant believes the rejection of these claims is overcome at least for the reasons given above. Accordingly, it is respectfully requested that the rejection of claims 24, 26-27, 29-31 and 33 be withdrawn.

In view of the foregoing amendments and remarks, the pending claims are deemed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this paper to deposit account No. 05-0649.

Respectfully submitted,



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